

## REMARKS/ARGUMENT

### Description of amendments

Claims 9, 19, 20, 23 and 24 are currently amended. Claims 1-15 and 18-26 are pending after entry of this Amendment, of which Claims 2, 3, 10, 12, 15, 18 and 26 are withdrawn as subject to a restriction requirement. No new matter is introduced by this Amendment.

Applicants respectfully request reconsideration and reexamination in view of the foregoing claim amendments and remarks presented below. Should these claims and remarks fail to persuade the Office to withdrawal the prior art rejections set forth in the May 25, 2007 Official Action, Applicants would appreciate if the Office could please indicate the specific reasons why Applicants' claims and remarks did not overcome the rejections. If these reasons are provided, Applicants will then know better how to proceed so that prosecution and/or appeal of the claimed subject matter is not needlessly prolonged. *See* MPEP § 707.07(f), which also applies when there is an alleged "new" ground of rejection. *Id.*

### Previous rejection under 35 U.S.C. § 102(b)

Applicants wish to thank the Examiner for withdrawing the rejection under 35 U.S.C. § 102(b) in light of Applicants' February 26, 2007 traversal of that rejection.

### Rejections under 35 U.S.C. §103(a)

Claims 1, 4-9, 11, 13-14 and 19-25 are rejected under 35 U.S.C. 103(a) as obvious over US4846791 ("Hattler") in view of US5674208 ("Berg"). Claims 1, 4-9, 11, 13-14 and 19-25 are also rejected under 35 U.S.C. 103(a) as obvious over US4846791 ("Hattler") in view of US5389106 ("Tower").

As best understood, the Official Action rejected the claims over both combinations of the prior art for essentially the same reason. Therefore, for the sake of brevity, both of these rejections will be discussed together.

The Official Action maintains that Hattler's tube could be replaced by a catheter having a metal braid (Berg) or a wire stent embedded in a polymer membrane (Tower). The asserted motivation to combine Berg or Tower with Hattler are either (1) that one of ordinary skill in the

art would have expected similar results using either Tower's stent or Berg's catheter, or (2) that the "resistance to longitudinal compression" offered by Berg's catheter or Tower's stent would have motivated one of ordinary skill to use it in place of Hattler's tube. As a result, the Official Action concludes that it would have been obvious to make either of the asserted combinations in order to arrive at Applicants' claimed invention. Applicants traverse both of these rejections for at least the following reasons.

Berg discloses a guide catheter having an outer tubular member 12 surrounding an inner tubular member 13. A steel braid or support 15 is between the inner and outer tubular members. *See col. 2, ll. 57-62 and Fig. 3 of Berg.* Tower discloses a stent that consists of a synthetic polymer 28 bonded to a metal sleeve 14. The bonded sleeve 14/membrane 28 form an impermeable wall between the exterior and inner lumen of the stent. *See col. 4, ll. 6-8 and 24-29 of Tower.* In each of these references, the device forms a fluid impermeable wall between the exterior and the inner surfaces of a lumen.

*Claims 9, 19, 20, 23 and 24*

Each of independent Claims 9, 19, 20, 23 and 24 are directed to different embodiments of a stent and a stent mandrel supporting the stent. Claims 9, 19, 20, 23 and 24 are amended to recite a stent comprising a plurality of struts having abluminal surfaces and luminal surfaces in fluid communication through at least a pair of the plurality of struts. Support for the amendments to the claims may be found at the paragraph beginning on line 21 of page 1, FIG. 1, the paragraph beginning on line 19 of page 9, and FIG. 2 of Applicants' specification.

Claim 9 would not have been obvious over Hattler and Berg, nor Hattler and Tower because substitution of Hattler's tube with a stent comprising a plurality of struts having abluminal surfaces and luminal surfaces in fluid communication through at least a pair of the plurality of struts would have rendered the resulting structure unsuitable for Hattler's intended purpose. If the stent and stent mandrel support described in Applicants' claims were used in place of Hattler's device, there would be no fluid tight seal. Fluids within each of the asserted, separate lumens would leak from the outside surface and/or mix if the claimed stent and stent mandrel support were used, thereby defeating the purpose of a divider and the general purpose of Hattler's catheter, i.e., transporting fluids. For at least this reason, Applicants respectfully submit

that Claim 9 would not have been obvious and, therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Allowance of Claim 9 is earnestly solicited.

Claim 9 would also not have been obvious over Hattler, Tower and/or Berg because none of the asserted combinations of prior art teach all features of the claimed stent and stent mandrel support. As discussed above, Hattler, Berg and Tower disclose a fluid impermeable wall for the tube, catheter and stent, respectively. In contrast, Applicants' claim includes the feature of a stent comprising a plurality of struts having abluminal surfaces and luminal surfaces in fluid communication through at least a pair of the plurality of struts. As neither Hattler, Berg nor Tower teach or suggest at least a stent comprising a plurality of struts having abluminal surfaces and luminal surfaces in fluid communication through at least a pair of the plurality of struts, the rejection under 35 U.S.C. § 103(a) should be withdrawn. For this additional reason allowance of Claim 9 is earnestly solicited.

Claims 19, 20, 23 and 24 are also allowable over the cited art, at least for the reasons given above for Claim 9. Applicants therefore respectfully ask that the rejections under 35 U.S.C. § 103(a) of Claims 19, 20, 23 and 24 be withdrawn and these claims allowed as well.

*Claim 1*

Applicants traverse the rejection of Claim 1 for at least the following reason. Claim 1 states, *inter alia*, a third member connecting the first member to the second member and extending through a longitudinal bore of the stent, the third member shaped and/or sized to eliminate or substantially prevent a coating from being formed on a luminal surface of the stent during application of a coating substance to the stent. Applicants understand that the present Official Action maintains that "the third member shaped and/or sized to eliminate or substantially prevent a coating from being formed on a luminal surface of the stent during application of a coating substance to the stent" is nothing more than an "intended use" limitation. Applicants respectfully disagree. Applicants are not merely indicating an intended use; the third member shaped and/or sized to eliminate or substantially prevent a coating from being formed on a luminal surface of the stent is a structural limitation of the claimed support; namely, a size and/or shape structural limitation as would be apparent upon inspection of Applicants' description.

A size and/or shape requirement for a third member is discussed by way of examples in Applicants' specification. For example, on page 13, line 10 Applicants provide an example of the appropriate size and/or shape of a third member by reference to the embodiment illustrated in FIG. 4A. For this example, Applicants explain that if the distance "52" is too small, spray composition may wick and/or cause an undesirably film to form between stent struts and/or the luminal surface of the stent. If the distance is too great, coating will again form on the luminal surface of the stent. Accordingly, the size and/or shape of a third member is determined in light of these criterion. This is a structural limitation, not merely an indication of an intended use.

In order to anticipate or render obvious a claim, the prior art must disclose every limitation of the claim. The art of record is silent as to a size or shape of a third member that makes it capable of eliminating or substantially prevent a coating from being formed on a luminal surface of the stent. In this regard, it is noted that the Official Action has relied on the holding in *Ex parte Mashum* to support its position. Importantly, Applicants wish to point out that in regards to this case the MPEP specifically notes that the so-called "intended use" aspect of this case only applies if "the prior art apparatus teaches all the structural limitations of the claim". MPEP § 2115 (emphasis in the original). The third member being shaped and/or sized to eliminate or substantially prevent a coating from being formed on a luminal surface of the stent during application of a coating substance to the stent is a structural limitation, as would be readily understood by one of ordinary skill in the art reading Applicants' disclosure. See, e.g., page 13, line 10 to page 14, line 2 of Applicants' disclosure.

The Official Action has heretofore relied on a divider 30 in Hattler as an inherent teaching of a third member. Applicants respectfully request that the Office please identify the disclosure in Hattler that evidences an inherent teaching for shaping and/or sizing Hattler's divider so that the resulting structure would be capable of eliminating or substantially preventing a coating from being formed on a luminal surface of a stent during application of a coating substance to the stent. Applicants submit that there is no such teaching in Hattler, either for Applicants' purpose or as an inherent feature of Hattler's divider, for reasons totally unrelated to Applicants' invention. As such, the rejection of Claim 1 under 35 U.S.C. § 103(a) cannot stand because neither Hattler, Berg and/or Tower teach all of the structural limitations of Claim 1. For

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at least this reason, Applicants respectfully request that the rejections of Claim 1 be withdrawn and this claim allowed.

Claims 4-8 11, 13, 14, 21, 22 and 25 depend from, and therefore include all limitations of allowable Claims 1, 9, 20 and 25, respectively. As Claims 4-8 11, 13, 14, 21, 22 and 25 depend from allowable subject matter, they are also allowable at least for this reason.

Withdrawn Claims 2, 3, 10 and 12

Claims 2, 3, 10 and 12 are subject to a species-type restriction requirement. As these claims now depend from allowable parent claims, withdrawal of the restriction requirement and allowance of Claims 2, 3, 10 and 12 is also requested.

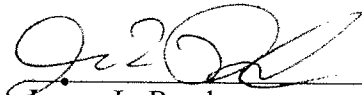
Conclusion

In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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